

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINYA KIMURA

Appeal No. 2007-0144
Application 09/846,907
Technology Center 2100

Decided: May 8, 2007

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1 and 2. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal invention is an access point device for limiting unauthorized access of mobile stations to a radio-based, wireless local area network ("LAN"). In recent years, the explosive prevalence of the Internet has increased the use of LANs in offices and homes. The need for wireless LANs, in particular, has increased. (Specification 1.)

When a wireless LAN is constructed within a closed space, i.e., an office or a home, the area covered thereby is susceptible to association from terminals of those with an evil intent. (*Id.* 8.) Accordingly, the Appellant's access point device notifies a network administrator of the presence of an authentication-requesting mobile station so as to gain the final authorization of an authentication. (*Id.*)

Claim 1, which further illustrates the invention, follows.

1. An access point device having an interface function with a network constructed of wired transmission channels and establishing data link connection with a plurality of mobile stations within the area of a radio LAN, the access point device comprising:

display means; and

input means,

wherein when performing an authentication procedure before a particular mobile station initiates an association

procedure, the display means displays information regarding the mobile station requesting authentication to a LAN administrator for final authorization of the authentication procedure when the mobile station is in the area in response to a notification of the presence of the authentication requesting mobile station, and wherein an authentication-authorizing or rejecting instruction for the mobile station displayed by the display means can be entered via the input means by the network administrator.

B. REJECTIONS

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,539,824 ("Bjorklund"). We reject the same claims as indefinite under 35 U.S.C. § 112, ¶2. Our opinion addresses the rejections in the following order:

- indefiniteness rejection
- anticipation rejection.

II. INDEFINITENESS REJECTION

Under 37 C.F.R. § 41.50(b) (2006), we enter a new rejection against claims 1 and 2.

A. PRINCIPLES OF LAW

The second paragraph of 35 U.S.C. § 112 requires that a specification conclude "with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361,

31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir.1991)). The "inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In particular, a claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited. . . ." *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (B.P.A.I. 1987).

B. ANALYSIS

Here, claim 1 recites in pertinent part "the network administrator." No such "network administrator," however, was previously recited in the claim. Furthermore, the relation between "the network administrator" and the "LAN administrator," which was previously recited in the claim, is uncertain. Those of skill in the art would not understand whether these expressions refer to the same or different entities. Nor would they understand whether the "authentication-authorizing or rejecting instruction" is input by the same entity to which the "information regarding the mobile station" is displayed.

The claim's recitation of both "a network constructed of wired transmission," (pmb1.), and "a radio LAN," (*id.*), imply that the "network administrator" and the "LAN administrator" are different entities that

administer the two different networks. In contrast, the specification's mentions of "a network administrator administering the LAN," (Specification 8), may imply that the "network administrator" and the "LAN administrator" are the same entity that administer the same LAN. Under the latter interpretation, however, it is unclear whether that LAN is the "Radio LAN." It is also uncertain whether the "network administrator," the "LAN administrator," or both administer the wired network.

The Appellant's repeated references to "the network administrator" and the "LAN administrator" in contesting the Examiner's rejection, (Br. 17-22; Reply Br. 4-5, 7, 9-11), emphasize the need to understand the scope of these terms. Therefore, we reject claim 1 and claim 2, which depends therefrom, as indefinite.

III. ANTICIPATION REJECTION

We now turn to the Examiner's rejection of claims 1 and 2.

A. PRINCIPLES OF LAW

An art rejection should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become

obvious -- the claim becomes indefinite." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

B. ANALYSIS

Here, for the reasons mentioned regarding the indefiniteness rejection, speculations and assumptions would be required to decide the scope of claim 1. Therefore, we reverse *pro forma* the anticipation rejection of the independent claim and of claim 2, which depends therefrom. We emphasize that our reversal is based on procedure rather than on the merits of the rejection. The reversal does not mean that we consider the claims to be patentable *vel non* as presently drafted.

IV. ADDITIONAL OBSERVATIONS

The Examiner objected to the Appellant's Brief on Appeal for "fail[ing] to include much material being referenced from the specification." (Answer 3.) "It is Appellant's belief[, however,] that particularly in view of the short nature of the present specification and the concentration of the description of its operation at the sections of the specification specifically referenced in APPELLANT'S SUMMARY OF THE CLAIMED SUBJECT MATTER as originally filed as part of its BRIEF ON APPEAL, that the SUMMARY [sic] OF THE CLAIMED SUBJECT MATTER as presented in its BRIEF ON APPEAL is appropriate under the Rules." (Reply Br. 2.)

A. PRINCIPLE OF LAW

The following rule applies to appeal briefs.

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

37 C.F.R. § 41.37(c)(1)(v)(2005).¹ Such identification is "considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." M.P.E.P. § 1205.02 (8th ed., Rev. 2, Aug. 2005).²

B. ANALYSIS

Here, claim 1 included means-plus-function elements. The Appellant's SUMMARY OF CLAIMED SUBJECT MATTER, (Br. 5-7), however, fails to identify these elements and to set forth the structure described in the specification as corresponding to each claimed function with reference to the

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief.

² We cite to the version of the Manual of Patent Examining Procedure in effect at the time of the Appeal Brief.

specification by page and line number, and to the drawings by reference characters. We decline to substitute speculation about where the structure corresponding to the claimed subject matter is described in the application for the greater certainty that should come from the Appellant. He should read independent claim 1 and any separately argued dependent claims on the specification and drawings. In particular, a mapping of each of the claimed limitations to specific reference characters of the drawings and pages and lines of the specification and is needed for a meaningful review. Fortunately, the Appellant did so in "the APPENDIX to this REPLY TO THE EXAMINER'S ANSWER. . . ." (Reply Br. 2.)

V. CONCLUSION

In summary, a rejection of claims 1 and 2 under 35 U.S.C. § 112, & 2 is added. The rejection of the same claims under § 102(b) is reversed *pro forma*.

37 C.F.R. § 41.50(b)(2006) provides that "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

- (1) Submit an appropriate amendment of the claims so

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rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . .

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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REVERSED
41.50(b)

Kis/gw

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